



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,607	03/15/2004	Hiroshi Yasuda	116692005400	8412

25227 7590 12/07/2006
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN, VA 22102

EXAMINER

TRAN, QUOC A

ART UNIT PAPER NUMBER

2176

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,607

Applicant(s)

YASUDA ET AL.

Examiner

Tran A. Quoc

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-6, 7, and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☒ Some * c) ☐ None of:

1) ☒ Certified copies of the priority documents have been received.

2) ☒ Certified copies of the priority documents have been received in Application No. JAP 2003072627 and JAP 2003072628 both filed 03/17/2003.

3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is a final rejection in response to amendment filed on 09/21/2006.
2. Claims 1, 3, 5-6, 7, and 9-12 are pending. Claims 2, 4 and 8 are canceled.
3. Claims 1, and 7 are amended.
4. Effective filing date 03/15/2004, benefit from foreign priority JAP 2003072627 and JAP 2003072628 both filed 03/17/2003.

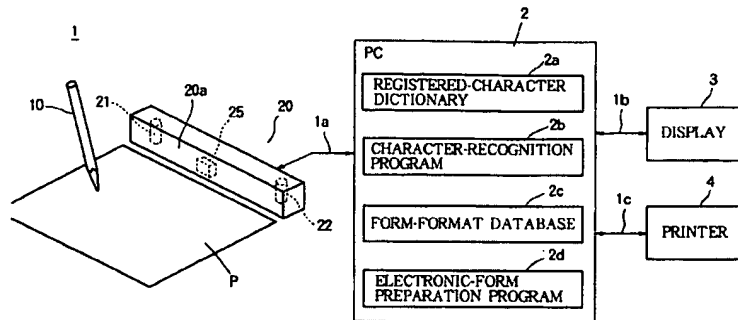
Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1 and 7** rejected under 35 U.S.C. 102(b) as being anticipate by US 20010016856A1 Published 08/23/2001 (hereinafter Tsuji).

Regarding independent claim 1, Tsuji teaches, **a receiving terminal configured to acquire handwritten information that is handwritten on a document**. Specifically Tsuji discloses a pc, a display, and the coordinate-input device 1 that includes an input pen for handwriting characters into a form P of a predetermined format (Tsuji, page 2 para 37-39. Fig. 1),

FIG. 1



Additionally, Tsuji teaches, **a document receiving terminal configured to receive the handwritten information that is transmitted from the receiving terminal.** For example Tsuji discloses a pc, a display, and the coordinate-input device 1 that includes an input pen for handwriting characters into a form of a predetermined format wherein the PC2 includes a character-recognition unit for recognizing characters written into the form P by the input pen 10 on the basis of coordinates supplied from the coordinate-input device 1, and an electronic-form preparation unit for preparing an electronic form using the characters recognized by the character-recognition unit. These units are realized by a registered-character dictionary 2a, a character-recognition program 2b, a form-format database 2c, and an electronic-form preparation program 2d (Tsuji page 2 para 37-40, Fig. 1).

Also Tsuji teaches, **a format storage terminal configured to store a format of the document.** For example Tsuji discloses and a format storage terminal configured to store a format of the document (Tsuji, page 2 para 42).

Furthermore Tsuji teaches, **wherein the receiving terminal includes: a format acquisition part, which acquires the format of the document from the format storage**

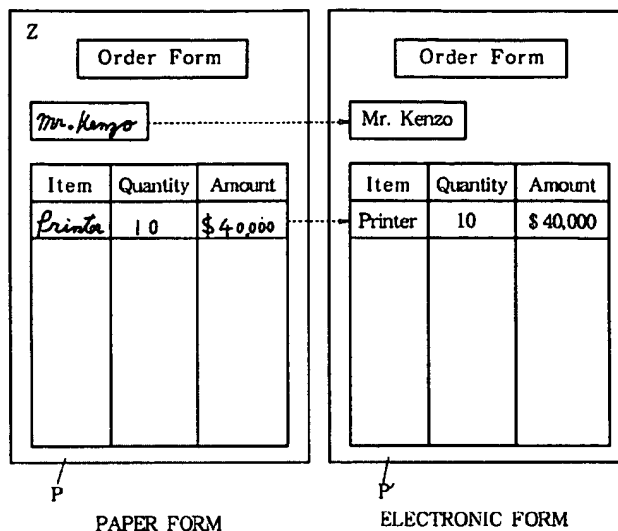
Art Unit: 2176

terminal. For example Tsuji discloses a format storage terminal configured to store a format of the document, wherein the form-format database 2c stores form-format data for various types of form having a specific format (Tsuji, page 1 para 14, and at page 2 para 42).

Additionally, Tsuji teaches, **a handwritten information acquiring part, which acquires the handwritten information that is handwritten on the document.** Specifically Tsuji discloses an input pen including a writing member for handwriting characters into a form having a predetermined format, and a transmitter provided in the vicinity of a tip of the writing member for emitting a signal when making entries into the form by the input pen is started (Tsuji page 1, para 7, and at page 2, para 42).

Also Tsuji teaches **a handwritten information transmitting part, which transmits the handwritten information to the document receiving terminal.** For example Tsuji discloses in FIG. 6, a view explaining the operation of preparing an electronic form. In FIG. 6, P represents a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4 (Tsuji, page 4, para 68, Fig. 6).

FIG. 6



Additionally, Tsuji teaches a **printing part, which prints the document based on the format acquired by the format acquisition part**. For example Tsuji discloses in FIG. 6 a view explaining the operation of preparing an electronic form. In FIG. 6, P represents a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4 (Tsuji, page 4 para 68, Fig. 6).

Furthermore Tsuji teaches, **the printing part prints identifier information, by which the handwritten information acquiring part identifies the document with the document**. Specifically Tsuji discloses item P in fig. 6, which represents a form into which characters are written by the input pen item 10 in fig. 6, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer item 4 fig. 1 (Tsuji, page 4 para 68. Fig. 6, Fig. 1). Additionally, Tsuji discloses the letter Z serving as an identification ID of the form P and when the letter Z in the form P is traced by the input pen 10,

the main unit 20 can determine the coordinates of a series of points constituting a part of the locus of the letter Z. Next, "Mr. Kenzo", "Printer", "\$4,000" are entered into boxes in the form P (Tsuji, page 4 para 68-69, Fig. 6).

Regarding independent claim 7, incorporate substantially similar subject matter as cited in claim 1 above, and is similarly rejected along the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 3, 5-6 and 9-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuji et al. US 20010016856A1 Published 08/23/2001 (hereinafter Tsuji), in view of Lerner et al US 20040172595A1 Division of 09/521,022 filed 03/07/2000 (hereinafter Lerner).

Regarding claim 3, wherein the receiving terminal further includes: a certifying part, which transmits and received necessary information for the certification to and from the certifying terminal, (see Tsuji at page 4 paragraph [0068] also see Fig. 6), discloses in FIG. 6 is a view explaining the operation of preparing an electronic form. In FIG. 6, P represents a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4.

an accounting process part which collects a service fee required based on printing of a publication document which is published based on an application made by the document; and a publication document information acquiring part which acquires information regarding the publication document from the document receiving terminal (see Tsuji at page 4 paragraphs [0068]-[0069] also see Fig. 6), discloses in FIG. 6 is a view explaining the operation of preparing an electronic form. In FIG. 6, P represents a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4. Further Tsuji discloses the letter Z serving as an identification ID of the form P is printed beforehand at the upper left corner of the form P. When the letter Z in the form P is traced by the input pen 10, the main unit 20 can determine the coordinates of a series of points constituting a part of the locus of the letter Z. Next, "Mr. Kenzo", "Printer", "\$4,000" are entered into boxes in the form P. The main unit 20 determines coordinates of a series of points constituting a part of each of these entered letters or characters. These determined coordinates are stored in the data storage unit 44 in pen-stroke blocks (i.e. using the broadest interpretation the Examiner reads the above as an obvious variant as claimed).

Tsuji does not explicitly teach, **a certifying terminal configured to certify a user who handwrites the handwritten information on the document, certifying part which transmits and received necessary information for the certification to and from the certifying terminal**, however (see Lerner at page 1 paragraph [0006] page 3 paragraph [0043] also see Fig. 3), discloses the invention relates to the integration of any annotation, including ink, highlighter, text-based notes and audio, directly into a Web-based document (WBD) displayed by a Web

browser, wherein users may annotate blank WBD, effectively converting their Web browsers into online notebooks/scrapbooks that includes User password for access right.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Tsuji's teaching, to include a means of certifying terminal configured to certify a user who handwrites the handwritten information on the document, certifying part which transmits and received necessary information for the certification to and from the certifying terminal of Lerner. One of ordinary skill in the art would have been motivated to modify this combination, because they are from the same field of endeavor of electronic document authoring, delivering, rendering, representing and executing using digital annotation (i.e. stylus, digital pen...), and provides user password for access right for security purpose (see Lerner at page 3 paragraph [0043]).

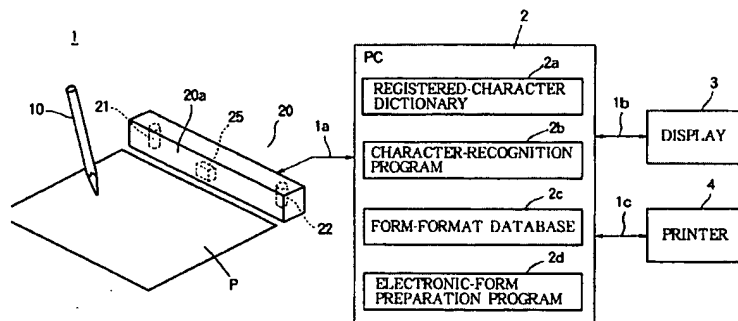
Regarding claim 5, wherein the format of the document is determined by the information regarding the certification acquired by the certifying part (see Tsuji at page 1 paragraph [0014] and at page 2 paragraph [0042]), discloses and a format storage terminal configured to store a format of the document, wherein the form-format database 2c stores form-format data for various types of form having a specific format; further (see Tsuji at page 1 paragraph [0014] and at page 2 paragraph [0042]), discloses and a format storage terminal configured to store a format of the document, wherein the form-format database 2c stores form-format data for various types of form having a specific format).

Regarding claim 6, wherein the handwritten information that is edited is transmitted to the document receiving terminal with the information of the document in a case where the certification is confirmed by the certifying part, and information about the

Art Unit: 2176

publication document is transmitted from the document receiving terminal to the publication document information acquiring part (see Tsuji at page 1 paragraph [0014] and at page 2 paragraph [0042]), discloses and a format storage terminal configured to store a format of the document, wherein the form-format database 2c stores form-format data for various types of form having a specific format; further (see Tsuji at page 2 paragraphs [0037]-[0039] also see Fig. 1), discloses a pc, a display, and the coordinate-input device 1 that includes an input pen for handwriting characters into a form P of a predetermined format.

FIG. 1



(see Tsuji at page 2 paragraphs [0037]-[0040] also see Fig. 1), discloses a pc, a display, and the coordinate-input device 1 that includes an input pen for handwriting characters into a form of a predetermined format wherein the PC2 includes a character-recognition unit for recognizing characters written into the form P by the input pen 10 on the basis of coordinates supplied from the coordinate-input device 1, and an electronic-form preparation unit for preparing an electronic form using the characters recognized by the character-recognition unit. These units are realized by a registered-character dictionary 2a, a character-recognition program 2b, a form-format database 2c, and an electronic-form preparation program 2d.

(see Tsuji at page 4 paragraph [0068] also see Fig. 6), discloses in FIG. 6 is a view explaining the operation of preparing an electronic form. In FIG. 6, P represents a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4.

FIG. 6

Order Form

Mr. Kenzo

Item	Quantity	Amount
Printer	10	\$40,000

P
PAPER FORM

Order Form

Mr. Kenzo

Item	Quantity	Amount
Printer	10	\$40,000

P'
ELECTRONIC FORM

Regarding claim 9, incorporate substantially similar subject matter as cited in claim 3 above, and is similarly rejected along the same rationale.

Regarding claim 10, incorporate substantially similar subject matter as cited in claims 1, and 7 above, and is similarly rejected along the same rationale.

Regarding claim 11, incorporate substantially similar subject matter as cited in claims 3, and 7 above, and is similarly rejected along the same rationale.

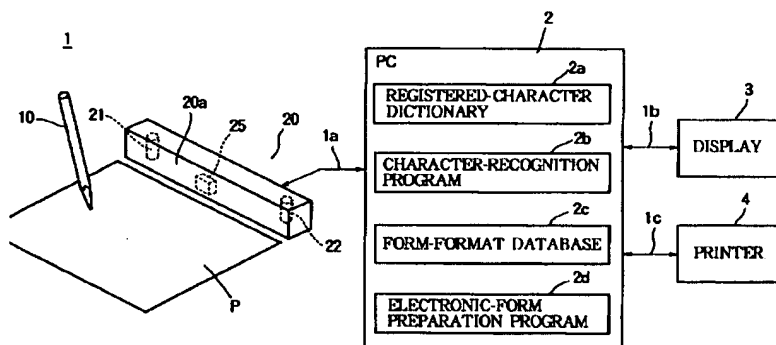
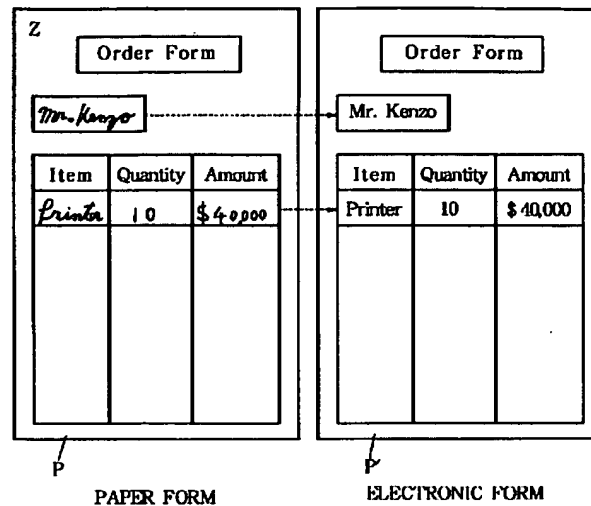
Regarding claim 12, incorporate substantially similar subject matter as cited in claims 3, 5 and 7 above, and is similarly rejected along the same rationale.

Response to Argument

8. Applicant's arguments filed 09/21/2006 have fully consider but they are not persuasive. Regarding independent claims 1, and 7, Applicant argues that the references do not teach **the printing part prints identifier information, by which the handwritten information acquiring part identifies the document with the document, because Tsuji's Fig. 6 and paragraph [0068] do not disclose that the printing part prints identifier information, by which the handwritten information acquiring part identifies the format of the document, with the document. They merely explain that P represents a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or printed out by the printer 4.**

The Examiner disagrees. Specifically, Tsuji discloses the letter Z serving as an identification ID of the form P and when the letter Z in the form P is traced by the input pen 10, the main unit 20 can determine the coordinates of a series of points constituting a part of the focus of the letter Z, and represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer item 4 fig. 1 (Tsuji, page 4 para 68-69, Fig.1 and 6).

[0068] FIG. 6 is a view explaining the operation of preparing an electronic form. In FIG. 6, P represents a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4. [0069] The letter Z serving as an identification ID of the form P is printed beforehand at the upper left corner of the form P. When the letter Z in the form P is traced by the input pen 10, the main unit 20 can determine the coordinates of a series of points constituting a part of the locus of the letter Z. Next, "Mr. Kenzo", "Printer", "\$4,000" are entered into boxes in the form P. The main unit 20 determines coordinates of a series of points constituting a part of each of these entered letters or characters. These determined coordinates are stored in the data storage unit 44 in pen-stroke blocks.



Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2176

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Herndon R. Heather can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Heather R. Herndon
Supervisory Patent Examiner
Technology Center 2100

Quoc A. Tran
Patent Examiner
Technology Center 2176
December 3, 2006